

## REMARKS

The invention claimed in the present application is directed to essentially dry compositions that contain a high intensity sweetener and exhibit good solubility despite the presence of relatively insoluble, poorly wetting, or hydrophobic ingredients. In particular, the compositions of the present invention have enhanced dispersibility when added to a liquid (*e.g.*, water) and, therefore, enhanced solubility by virtue of the defined particle size of the sweetener therein. The essentially dry compositions of the present invention are suitable for use as foods and/or beverages.

Claims 1-85, 93-98 and 102 are currently pending. Applicants have requested an amendment of only Claim 102.

### A. Amendment of Claim 102

The Examiner states that Claim 102 reads on a composition having no bulking agent. That was not the intent when that claim was presented in Applicants' prior response. Rather, Applicants intended to cover essentially dry compositions with a bulking wherein the bulking agent isn't present in an amount greater than about 96% by weight.

Applicants respectfully request entry of this amendment in view of the oversight. Applicants submit that this after-final amendment is appropriate in view of 37 C.F.R. §1.116(c), as the reason the claim was not presented in the form currently presented was Applicants' oversight in not recognizing the breadth of the claim limitation in question. Furthermore, entry of the amendment will put the claim in better condition for appeal, should the Examiner maintain that the claimed compositions are not patentable. Rule 116(b). Applicants request that the Examiner use her discretion under Rule 116 to allow the after-final amendment in this instance.

### B. Rejection under Section 112, second paragraph

~~Claim 102, which was added in Applicants' previous response, is rejected as being indefinite~~ under 35 USC 112, second paragraph. The Examiner asserts that the phrase "consisting essentially of" is indefinite because "[i]t is not known what is meant by this phrase because it is not known what ingredients are intended to be excluded by this phrase."

Applicants respectfully submit that this transitional phrase is one that has long been accepted as proper according to U.S. patent practice. See, *e.g.*, MPEP § 2111.03 and Chisum on Patents, Section 8.06. And the courts have long recognized the appropriateness of a consisting essentially of transition in patent claims. For example, in PPG Industries v. Guardian Industries Corp., 156 F.3d 1351, 1354 (Fed. Cir. 1998), the Court of Appeals for the Federal Circuit (CAFC) recently stated that

"Consisting essentially of" is a transition phrase commonly used to signal a partially open claim in a patent. Typically, "consisting essentially of" precedes a list of ingredients in a composition claim or a series of steps in a process claim. By using the term "consisting essentially of," the drafter signals that the invention necessarily includes the listed ingredients and is open to unlisted

ingredients that do not materially affect the basic and novel properties of the invention. A “consisting essentially of” claim occupies a middle ground between closed claims that are written in a “consisting of” format and fully open claims that are drafted in a “comprising” format.

Importantly, while acknowledging that the patent in question “contains some inherent imprecision resulting from the use of the term ‘consisting essentially of,’” the Court did not find the claim insufficiently inherent. *Id.* at 1355. Rather, the court discussed whether interpretation of the phrase was one of claim construction for the court or infringement assessment for the jury. In this regard, Applicants’ attorney is aware of no precedent holding that the mere inclusion of the transitional phrase “consisting essentially of” renders a claim indefinite under Section 112, second paragraph.

Based on the foregoing, Applicants request withdrawal of the indefiniteness rejection.

C. Rejection under Section 102(b)

Claim 102 is rejected under 35 USC 102(b) over U.S. Patent 5,473,097 to Kishimoto (“Kishimoto”). The Examiner states that “Kishimoto et al. disclose a dry composition containing only aspartame in particle sizes greater than 106 microns and less than 96% bulking agent in that ‘less than 96%’ reads on zero amounts and the composition is considered to be a food as it is ingestible.”

As mentioned in section A above, Applicants have requested an amendment to Claim 102, to clarify that the dry composition does contain bulking agent. In view of that amendment, Applicants submit that the Claim 102 is not anticipated by Kishimoto. Applicants therefore request withdrawal of the rejection.

D. Rejections under Section 103(a)

Claims 1, 2, 14-29, 45-85 and 102 are rejected under 35 U.S.C. 103(a) over U.S. Patent No. 6,399,132 to Ishida et al. (“Ishida”) or U.S. Patent No. 5,968,580 to Chuang et al. (“Chuang”) in view of the Sweet’n Low product. In the discussion below, Applicants discuss Claims 1, 2, 14-29 and 45-85 separate from Claim 102.

Claims 30-44 and 93-98 are rejected under 35 U.S.C. 103(a) over U.S. Patent No. 6,399,132 to Ishida et al. (“Ishida”) or U.S. Patent No. 5,968,580 to Chuang et al. (“Chuang”) in view of the Sweet’n Low product and Kishimoto.

1). Rejection of Claims 1, 2, 14-29, and 45-85

With respect to Claims 1, 2, 14-29, and 45-85, the Examiner states that “[t]he independent claims are rejected for the reasons of record cited in the last office action and for these further reasons.”

Before addressing the ‘further reasons,’ Applicants respectfully submit that the simple statement maintaining the prior rejections, without a discussion of how the references teach the

limitations of the claims, particularly the bulking agent limitation added to the claims in the prior response, is not sufficient to permit a meaningful response by Applicants. MPEP § 706.02(j) provides that to maintain a proper Section 103 rejection

the examiner should set forth in the Office action (A) the relevant teachings of the prior art, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate, (B) the difference or differences in the claim over the applied reference(s), (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (D) an explanation why one of ordinary skill in the art at the time of the invention was made would have been motivated to make the proposed modifications.

Applicants respectfully submit that the Examiner has not properly set forth a rejection, insofar as she simply incorporates the rejections set forth in the prior Action. All of the claims presented in the prior response were amended to add the limitation around the amount of the bulking agent. As the reasons for rejection in the prior Action said nothing about the level of bulking agent described by the references, this aspect of the Examiner's present rejection improperly omits, at a minimum, the requisite specificity required by subsections (B) and (C) of MPEP § 706.02(j).

The Examiner refers to Claim 1's element requiring from about 50 to about 96%, by weight, of a bulking agent. The Examiner indicates that this is in the range disclosed by the Sweet'n Low product. She also refers to Kishimoto for the teaching of aspartame particle sizes in the 100 to 500 micron range. She then concludes that "it would have been obvious to use the claimed amount and particle size in the process of Ishida et al. or Chuang et al. because these references disclose the higher range of more than 106 microns and Kishimoto et al. discloses usefulness of the lower range of 150."

As an initial matter, Applicants respectfully submit that it is not clear from the rejection how the various references are being combined in rendering the claims obvious. Are the teachings of all four (4) references being combined, or are Ishida and Chuang each being modified by the other two references to result in two separate obviousness rejections? Clarification is requested. (Applicants proceed under the assumption that the mentioned claims are rejected over Ishida in view of Sweet'n Low and Kishimoto and separately over Chuang in view of Sweet'n Low and Kishimoto.)

As was discussed in the prior response, to establish a *prima facie* case of obviousness (per Section 706.02(j) of the MPEP), the Examiner must meet three basic criteria:

- (1) First, there must be some suggestion or motivation in the prior art to modify the reference or to combine reference teachings.
- (2) Second, there must be a reasonable expectation of success in obtaining the claimed invention based upon the references relied upon by the Examiner.
- (3) Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Regardless of how the references are being combined, Applicants again submit that the Examiner has failed to meet at least criteria 1 and 3 of MPEP § 706.02(j) in the present Action. First, the Examiner has shown no motivation in the art to combine, in any manner, the references' teachings in the first instance. Ishida's primary teaching is that the inclusion of Ace-K with aspartame, in specifically defined ratios, enhances the solubility of the aspartame. Chaung is directed to tea-solids containing beverages that have reduced sediment qualities. The Sweet'n Low product is a saccharin-containing sweetener system that is not typically ingested itself, but instead is used to sweeten food or beverage products. And Kishimoto is directed to granules of aspartame that include crystals in the IB form (IB crystals) where those crystals have a particular grain size range. Clearly, these prior art items are very different from one another. One skilled in the art therefore would have no motivation to look to the Sweet'n Low product or the Kishimoto reference to modify the teachings of Chaung or Ishida. Nothing in any of the references cited suggests combining their disclosure with any of the other references. Applicants respectfully submit that no such motivation exists in the prior art generally. Because the Examiner has not satisfied the first prong of MPEP § 706(j), Applicants submit that the Section 103 rejection is improper.

A complete consideration of each reference's teachings will demonstrate that even if combined, the references do not teach Applicants' claimed compositions as required by the third prong of MPEP § 702(j). Specifically, the Examiner has provided no basis to establish that all the claim elements required by the pending claims are taught by the prior art.

As was noted in the prior rejection, Ishida emphasizes the importance of the Ace-K / aspartame relationship that results in enhanced solubility of the aspartame component. In discussing the aspartame aspect, Ishida suggests the use of aspartame having particle sizes smaller than those encompassed by Applicants' claims (i.e., 100 $\mu$ m). Indeed, one could interpret Ishida to suggest that smaller particle sizes (15  $\mu$ m) are better and that the presence of a bulking agent, per the present claims, would benefit even further by incorporation of smaller aspartame particles. This is discussed in Applicants' prior response, at pages 15-16. (The MPEP and case precedent clearly require that these teaching away aspects cannot be ignored in establishing a case of *prima facie* obviousness.) Ishida also contains little disclosure around the use of a bulking agent. There is clearly no teaching of including from about 50 to about 96% bulking agent, as required by the relevant claims.

The Examiner acknowledges that Ishida does not teach the invention and apparently relies on the Sweet'n Low product to teach Applicants' bulking agent limitation (about 50 to about 96%) and Kishimoto to teach the high intensity sweetener particle size (greater than 106  $\mu$ m). Applicants note that they have not confirmed that the Sweet'n Low product includes a bulking agent in Applicants' claimed range. In any event, though, the Examiner has shown no reason to conclude that the skilled artisan would have taken this teaching from the Sweet'n Low product and combined it with the teaching of Ishida. And what's more, even after combining those teachings to get to the bulking agent

limitation, one still does not arrive at the claimed high intensity sweetener particle size. For this, the Examiner relies on Kishimoto. Without delving into the shortcomings of Kishimoto in terms of its alleged disclosure of an aspartame particle size greater than 106 $\mu$ m (the reference actually talks about the size of certain aspartame crystals as part of an aspartame granule composition), Applicants submit that there is simply no motivation to combine those specific aspects of Kishimoto with both Ishida and Sweet'n Low. Indeed, in piecing together the rejection based on Ishida, Sweet'n Low and Kishimoto, the Examiner is clearly picking and choosing from the various references' teachings to attempt to arrive at Applicants' claimed compositions. However, the picking and choosing is done without any guidance from the teachings of the reference. So, even if one were motivated to combine the references' teachings in the first instance, one does not arrive at a composition having high intensity sweetener where at least about 50% of the particles have a particle size greater 106  $\mu$ m and having a bulking agent at a level of from about 50 to about 96%. As the combination of references does not teach all the claim limitations, the Examiner's rejection is improper and Applicants request withdrawal of this aspect of the obviousness rejection.

As discussed in Applicants' prior response, Chaung is directed to tea-containing beverage mixes comprising tea solids, bulk aspartame and aspartame-coated acid. While describing the components and their preferred levels in some detail, Chaung merely mentions, at Col. 3, that additional functional agents - flavor enhancers, colors, vitamins, minerals, and flow agents - may also be included. There is no teaching or suggestion of including the bulking agents required by Applicants' claims. Further, no levels of the optional functional agents is provided. The only mention of the amount of these functional ingredients is in Examples 1 and 2, which include 6.1% and 8.4%, respectively. So, to the extent Chaung discusses bulking agents in passing, the levels are much lower than the ranges in Applicants' Claims 1, 2, 14-29 and 45-85.

The Examiner properly concludes that Chaung by itself does not teach or suggest compositions containing the bulking agent required by Applicants' Claims 1, 2, 14-29 and 45-85. Indeed, to the extent Chaung teaches any specificity as to the level of bulking agent to include, the suggestion is to use levels far below Applicants' claimed range of from about 50 to about 96%. As with the shortcoming of Ishida, the Examiner relies on the Sweet'n Low product to teach the bulking agent and Kishimoto to teach the high intensity sweetener particle size. But again, this picking and choosing from the references both ignores some of the references' teachings and uses hindsight based on Applicants' disclosure to arrive at the claimed compositions. Again, Applicants respectfully submit that this combination of references does not teach all the claim limitations and withdrawal of this aspect of the obviousness rejection is requested.

Based on the foregoing, Applicants request the withdrawal of the Section 103 rejections and the allowance of Claims 1, 2, 14-29 and 45-85.

2). Rejection of Claim 102

The Examiner apparently rejects Claim 102 under Section 103 based on the same combination of references as Claims 1, 2, 14-29 and 45-85. The Examiner's rejection is based, apparently, on the fact that the Sweet'n Low product has a bulking agent (maltodextrin) presumably at a level below 96% by weight; the aspartame particle sizes set forth in Ishida, Chuang and Kishimoto are in Applicants' claimed range; and one skilled in the art would have been motivated to combine these specific teachings to arrive at the compositions of Claim 102.

Applicants again submit that the Examiner has failed to satisfy at least prongs 1 and 3 of MPEP § 706.02(j) to establish a *prima facie* case of obviousness. All of Applicants' arguments about combining the references' teachings in the first instance apply equally to Claim 102. And even if combined, there is no motivation to apply the alleged particle size teachings of Ishida, Chuang or Kishimoto to the Sweet'n Low product. Applicants respectfully submit that the subject matter of Claim 102 is not taught by the cited art. Withdrawal of the rejection is therefore requested.

3). Rejection of Claims 30-44 and 93-98

With respect to Claims 30-44, Applicants submit that these claims are narrower than Claim 1, insofar as they all require that a relatively higher level of the high intensity sweetener be of a particle size greater than 106  $\mu\text{m}$ . As such, Applicants submit that these claims are patentable over the cited art.

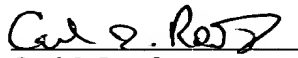
As for Claims 93-98, they are directed to beverages comprising the composition of the various dependent claims discussed herein. Because the compositions themselves are patentable over the prior art, beverage Claims 93-98 are also patentable.

Applicants request withdrawal of the rejection and allowance of Claims 30-44 and 93-98.

CONCLUSION

Applicants request entry of the amendment presented herein and consideration of the accompanying remarks. Applicants further request that the Examiner allow all pending claims in view of those remarks. A Notice of Appeal is being filed with this response.

Respectfully submitted,

  
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